UNITED STATES PATENT AND TRADEMARK OFFICE

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EXAMINER
HAILU, TESHOME

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/769,918	MULLER, THOMAS
	Examiner	Art Unit
	Teshome Hailu	2109

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*03 February 2004*</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>*03 February 2004*</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☒ All b)☐ Some * c)☐ None of:

      1.☒ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>*10/05/2004 and 06/02/2004*</u>.

4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1.   Claims 1-13 are pending.

Specification

2.   The disclosure is objected to because of the following informalities: The **"the examination software 305"** on page 13, paragraph 42 should be *"the examination software 302"*. Appropriate correction is required.

3.   The disclosure is objected to because of the following informalities: The **"an examination routine 306"** on page 13, paragraph 44 doesn't match with the drawing. Appropriate correction is required.

Claim Objections

4.   Claim 6 is objected to because of the following informalities: **"Generating the digital document"** should be *generating a digital document*. Appropriate correction is required.

Double Patenting

5.   Claims 1-13 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-14 of copending Application No. 10/769,919. Although the conflicting claims are not identical, they are not patentably distinct from each other because 1-13 of the instant application substantially recite the limitations of claims 1-14 of cited US application to check a digital document containing a digital signature. Therefore, it would have been obvious to one of ordinary skill in the art of data processing at the time the invention was made to modify the invention as claimed in the instance application by adding a pointer. Since an omission and addition of a cited limitation would have not changed the process according to which the method and system as claimed. Therefore, the use of adding a pointer would be an obvious variation in the art for the purpose of achieving the same end results of checking a digital

document containing a digital signature and would not interfere with the functionality of the steps previously claimed and would perform the same function.

Claim Rejections - 35 USC § 101

7.   Claims 1-9 and 11-13 are directed to functional descriptive material, which consists of a computer program per se that electronically signed documents with examination software. Since a computer program by itself, (i.e., without computer readable and/or storable medium), is not a process and does not fall within the statutory classes listed in 35 U.S. C. 101. The claims are believed to recite non-statuary subject matter. The examiner has suggested that a computer storable medium implementation needs to be added to the invention.

Claim Rejections - 35 USC § 102

8.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –

> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9.   Claims 1-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Brown et al (Brown), US PG PUBS 2003/0023850.

As per claim 1, Brown discloses:

- **A digital document containing a digital signature**, (page 1, paragraph 24, "*a digital signature for a sender of a message entry is attached to said message entry*").

- Wherein the document comprises a **piece of software for checking the digital signature**. (Page 4, paragraph 61, "Logging controller 62 is *advantageously a software application executing within messaging server 42 in order to control the process of*

obtaining and attaching digital signature to a log file."), where the logging controller software

is attached to log file repository further explained in figure 3 of the drawing.

As per claim 2, Brown discloses:

- **the software can be called up using a pointer**. (page 3, paragraph 46, "Web

pages may further include text, graphic images, movie files, and sounds as well as Java applets

and other small embedded *software programs that execute when the user activates them by*

clicking on a link."). Where a pointer 204 is a link as shown in figure 2 of the invention.

As per claim 3, Brown discloses:

- wherein the digital document has a format for enabling the digital document to

be **displayed in a web browser**. (page 3, paragraph 44, " with reference now to FIG. 2 there is

depicted a simplified block diagram of a client/server environment in which electronic messaging

typically takes place in accordance with the method, system and program of the present

invention"). Further Brown disclose that (page3, paragraph 46, "*Network 44, such as the*

Internet, provides an infrastructure for transmitting these hypertext documents between

client messaging systems 40a-40n and messaging server 42.")

As per claim 4, Brown discloses:

The digital document of claim 3, wherein the format is at least one of an **HTML,**

XML, or PDF format. (page 3, paragraph 46, "Documents (pages) on the web may be written in

multiple languages, such as *Hypertext Markup Language (HTML) or Extensible Markup*

Language (XML), and identified by Uniform Resource Indicators (URIs) that specify the particular

messaging server 42 and pathname by which a file can be accessed, and then transmitted from

messaging server 42 to an end user utilizing a protocol such as Hypertext Transfer Protocol

(HTTP).")

As per claim 5, Brown discloses:

- The digital document of claim 1, wherein the **software is contained in digital document**. (Page 4, paragraph 61, "Logging controller 62 is **advantageously a software application executing within messaging server 42 in order to control the process of obtaining and attaching digital signature to a log file.**"), where the logging controller software is attached to log file repository further explained in figure 3 of the drawing.

As per claim 6, Brown discloses:

- A method of **generating a digital document**, (Abstract, line 1-3, "A method, system and program for saving **logfiles of a messaging session with the digital signatures of participants in the messaging session is provided.**")

- **Creating a digital signature for an original document**: (page 2, paragraph 35, "A **"digital signature" may encompass multiple types of encryption methods utilized to verify the authenticity of signatures and the integrity of documents.**")

- **generating the digital document from the original document**: (Abstract, line 1-3, "A method, system and program for saving logfiles of **a messaging session with the digital signatures of participants in the messaging session is provided.**")

- adding to the digital document the digital signature and a pieces of software for checking the digital signature. (Page 4, paragraph 61, "Logging controller 62 is **advantageously a software application executing within messaging server 42 in order to control the process of obtaining and attaching digital signature to a log file.**"), where the logging controller software is attached to log file repository further explained in figure 3 of the drawing.

As per claim 7, Brown discloses:

- A method for checking a digital document **containing a digital signature**, wherein the document comprises a piece of **software for checking the digital signature**, the method comprising: **executing the software contained in the document**. (Page 4, paragraph 61, "Logging controller 62 is advantageously a **software application executing** within messaging server 42 in order to control the **process of obtaining and attaching digital**

signature to a log file."), where the logging controller software is attached to log file repository

further explained in figure 3 of the drawing.

As per claim 8, Brown discloses:

- The method of claim 6, wherein the original document is **selected from the**

group comprising of digital faxes, letters, agreements, certificates, invoices, orders, order

confirmations, and tax assessments. (page 1, paragraph 12, "One type of electronic

communication is supported by messaging which includes the use of computer systems and data

communication equipment to convey messages from one person to another, *as by e-mail, voice*

mail, unified messaging, instant messaging or fax."), according to the invention, paragraph

14, stated that a document within the meaning of an embodiment of the invention is an electronic

or digital *file having any content.*

As per claim 9, Brown discloses:

- A computer system comprising a **digital document** according to any of claims

1 to 5. (Page 1, paragraph 12, "One type of electronic communication is supported by messaging

which includes the use of computer system and data communication equipment to convey

messages from one person to another, as by *e-mail,* voice mail, unified messaging, instant

messaging, or fax."), where e-mail is one form of digital document

As per claim 10, Brown discloses:

- A computer system for **generating a digital document containing a digital**

signature, (Abstract, line 1-3, "*a messaging session with the digital signatures of*

participants in the messaging session is provided.")

- wherein the document comprises **software for checking the digital signature,**

(Page 4, paragraph 61, "Logging controller 62 is *advantageously a software application*

executing within messaging server 42 in order to control the process of obtaining and

attaching digital signature to a log file.")

      - means for **storing data**; means for **storing programs**; means for **executing program**; (Page 3, paragraph 40, "The present invention may be provided as a computer *program product, included on a machine-readable medium having stored thereon the machine executable instructions* used to program computer system 10 to perform a process according to the present invention.")

      - **program code means for performing a method of generating a digital document** (Abstract, line 1-3, "A method, system and *program for saving logfiles of a messaging session with the digital signatures of participants in the messaging session is provided.*")

      - **when executed by the means for executing programs,** (Page 3, paragraph 40, "a computer program product, *included on a machine-readable medium having stored thereon the machine executable instructions* used to program computer system 10 to perform a process according to the present invention.")

      - **creating a digital signature for an original document; generating a digital document from the original document;** (Abstract, line 1-3, "A method, system and program for saving logfiles of a *messaging session with the digital signatures of participants in the messaging session is provided.*")

      - **adding to the digital document the digital signature and software for checking the digital signature.** (Page 4, paragraph 61, "Logging controller 62 is advantageously a software application executing within *messaging server 42 in order to control the process of obtaining and attaching digital signature to a log file.*")

      As per claim 11, Brown discloses:

      - A computer program product comprising program code means for performing a method of *generating a digital document* (Abstract, line 1-3, "a program for saving logfiles of a *messaging session with the digital signatures* of participants in the messaging session is provided.")

- when **executed on a computer,** (Page 3, paragraph 40, "a computer program product, included on a machine-readable medium having stored thereon the machine *executable instructions used* to program computer system 10 to perform a process according to the present invention.")

      - creating a digital signature for an original document; generating a digital document from the original document; (Abstract, line 1-3, "A method, system and program for saving logfiles of a messaging session with the *digital signatures of participants in the messaging session is provided.")*

      - **adding to the digital document the digital signature and software for checking the digital signature.** (Page 4, paragraph 61, "Logging controller 62 *is advantageously a software application executing within messaging server 42 in order to control the process of obtaining and attaching digital signature to a log file."*)

      As per claim 12, Brown discloses:

      - **An electrical carrier signal comprising a computer program product** according to claim 11. (page 3, paragraph 42, "ISP 37 and *Internet 38 both use electrical, electromagnetic, or optical signals that carry digital data streams.")*

      As per claim 13, Brown discloses:

      A computer program product having program code means for causing a **processor of a computer to check a digital document containing a digital signature,** (Page 3, paragraph 40, "a computer program product, included on a machine-readable medium having stored thereon the machine executable *instructions used to program computer system 10 to perform a process according to the present invention.")*

      - the document comprising **software for checking the digital signature,** (Page 4, paragraph 61, "Logging controller 62 is advantageously a *software application executing within messaging server 42 in order to control the process of obtaining and attaching digital signature to a log file."*), where the logging controller software is attached to log file repository further explained in figure 3 of the drawing.

- the computer program product causing the computer to execute the following

step: **executing the software contained in the document**. (Page 4, paragraph 61, "Logging

controller 62 is ***advantageously a software application executing within messaging server***

42 in order to control the process of obtaining and attaching digital signature to a log file.")

Conclusion

10.   The prior art made or record and not relied upon is considered pertinent to applicant's

disclosure

TITLE: Verifying messaging sessions by digital signatures of participants, US Pub. No.

20030023850.

TITLE: Method for using pointers for pointing to examination software when generating and

examining electronic signatures or electronically signed documents, US Pub. No. 20040205346.

TITLE: Transaction method and system for data networks, like Internet, US 6,889,325.

Any inquiry concerning this communication or earlier communications from the examiner should

be directed to Teshome Hailu whose telephone number is (571) 270-3159. The examiner can

normally be reached on Mon-Fri 7:30a.m. to 5:00p.m. PST.

    If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Chamili Das can be reached on (571) 272-3696. The fax phone number for the

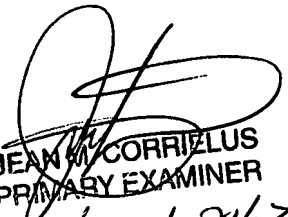organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent

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like assistance from a USPTO Customer Service Representative or access to the automated

information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Teshome Hailu

Patent Examiner

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5/25/07